

Serial No.: 10/065,281  
Attorney Docket No.: F-521

Patent

**REMARKS**

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**1. Status of Claims**

Claims 1-16 were pending in the Application. Applicants have amended claims 1, 8-11, and 14-16 without prejudice or disclaimer. Applicants have added new claims 17-20. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-20 will remain pending in the application.

**2. Objections to the Drawings**

In section 3 of the Office Action, the Examiner objected to the drawings for including character 62 not mentioned in the specification. Paragraph 38 has been amended to recite the connection 62 as supported by FIG. 1. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

**3. Objections to the Specification**

In section 4 of the Office Action, the Examiner objected to the specification. Applicants submit that the incorporation by reference are uniquely identified as required and furthermore have amended paragraphs 20-23 to provide the requested serial numbers that were assigned by the USPTO subsequent to filing. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

In section 5 of the Office Action, the Examiner objected to the specification due to noted informalities. Applicants have amended paragraphs 6 and 51 as suggested. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

**4. Objections to the Claims**

In section 7 of the Office Action, the Examiner objected to claim 8 due to the noted antecedent basis typographical error. Applicants have amended claim 8.

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Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

**5. Rejections under 35 USC § 103(a)**

In section 9 of the Office Action, the Examiner rejected Claims 1-8 and 11-13 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,307,956 to Black ("Black '956") in view of U.S. Patent Application Publication No. 2002/0057824 by Andreasson ("Andreasson '824") and further in view of U.S. Patent Application Publication No. 2002/0107885 by Brooks, et al. ("Brooks '885").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the references as stated as allegedly to reduce noise distortion. The cited references do not alone or in proper combination suggest or render obvious such a facsimile message composition process using remote attachments. Furthermore, none of the references teach or fairly suggest composing a facsimile using pen stroke to identify an attachment that is then appended to the facsimile message.

However, solely in order to expedite prosecution, Applicants have amended claims 1, 8, and 11 without prejudice or disclaimer and the rejection is moot.

With regard to claims 1 and 11, the cited references do not fairly teach or suggest at least:

processing the strokes in order to determine at least one attachment requested for the facsimile message;

receiving the at least one attachment from a server that is remote from the pointing instrument;

composing the facsimile message using the cover page template, the facsimile message data and the at least one attachment; and

sending the facsimile message to the recipient.

Applicants respectfully submit that the rejected dependent claims are patentable over the cited references for at least the reasons discussed above.

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Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1-8 and 11-13.

In section 10 of the Office Action, the Examiner rejected Claims 9 and 14 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,307,956 to Black ("Black '956") in view of U.S. Patent Application Publication No. 2002/0057824 by Andreasson ("Andreasson '824") and further in view of U.S. Patent Application Publication No. 2002/0107885 by Brooks, et al. ("Brooks '885") and further in view of U.S. Patent No. 6,895,507 to Teppler ("Teppler '507").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the references as stated in the case of Teppler '507 to preserve the integrity of digital files and trusted timestamps. Such a motivation is clearly not a proper motivation to combine in view of the presently claimed invention directed to facsimile composition using remote attachments.

However, solely in order to expedite prosecution, Applicants have amended claims 1, 8, 9, and 11 and 14 without prejudice or disclaimer and the rejection is moot. Claims 9 and 14 are patentable over the cited references for at least the reasons stated above with reference to the corresponding intervening claims.

Furthermore, with regard to claims 9 and 14, the cited references do not teach or fairly suggest:

verifying user permission to access the at least one attachment file and stopping the facsimile message composition process if the user does not have permission to access the at least one attachment file.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 9 and 14.

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In section 11 of the Office Action, the Examiner rejected Claims 10 and 15 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,307,956 to Black ("Black '956") in view of U.S. Patent Application Publication No. 2002/0057824 by Andreasson ("Andreasson '824") and further in view of U.S. Patent Application Publication No. 2002/0107885 by Brooks, et al. ("Brooks '885") and further in view of U.S. Patent No. 6,895,507 to Teppler ("Teppler '507") and further in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan ("Bohan '681").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the references as stated above.

However, solely in order to expedite prosecution, Applicants have amended claims 1, 8-11 and 14-15 without prejudice or disclaimer and the rejection is moot. Claims 10 and 15 are patentable over the cited references for at least the reasons stated above with reference to the corresponding intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 10 and 15.

In section 12 of the Office Action, the Examiner rejected Claim 16 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,504,956 [sic] to Gannage, et al. ("Gannage '956") in view of U.S. Patent No. 6,895,507 to Teppler ("Teppler '507").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the references as stated above and since neither cited reference relates to digital pen facsimile composition.

However, solely in order to expedite prosecution, Applicants have amended claim 16 without prejudice or disclaimer and the rejection is moot.

For example, the cited references do not teach or suggest:

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Claims 10 and 15 are patentable over the cited references for at least the reasons stated above with reference to the corresponding intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claim 16.

a file server connected to the processor, wherein the processor uses pen stroke data to locate the at least one attachment and uses pen stroke data to verify permission to access the at least one attachments;

the processor further configured to compose the facsimile message using the at least one attachment if permission to access the at least one attachment is verified; and

the processor further configured to send the facsimile message

Additionally, Applicants have added new dependent claims 17-20 and respectfully submit that the new claims are patentable over the cited references for at least the reasons described above regarding the corresponding intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-20 is patentable and in condition for allowance.

#### **6. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

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**7. Authorization**

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-521.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-521.

Respectfully submitted,

  
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